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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,314	10/24/2005	Anthony Rosenzweig	00786/431002	9779
21559	7590	05/25/2006	EXAMINER	
CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110			WHITEMAN, BRIAN A	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/534,314	ROSENZWEIG ET AL.	
	Examiner	Art Unit	
	Brian Whiteman	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15, 16, 20, 21, 29, 30, 42, 45-49, 51, 54 and 55 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 15, 16, 20, 21, 29, 30, 42, 45-49, 51, 54, 55 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 15, 16, 20, 21, 29, 30, 42, 45-49, 51, 54, and 55 are pending.

The cancellation of claims 1-14, 17-19, 22-28, 31-41, 43, 44, 50, 52, 53 and 56-64, the amendment to claims 16, 20, 21, 46-48, and 55 in paper filed on 5/9/05 is acknowledged.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 15, 16, and 21, drawn to a method of treating a cardiac disorder in a mammal comprising administering to said mammal a FADD protein.

Group II, claim(s) 15, 16, 20 and 21, drawn to a method of treating a cardiac disorder in a mammal comprising administering to said mammal an anti-inflammatory FADD inhibitor.

Group III, claim(s) 29, drawn to a human cardiomyocyte expressing a dominant negative FADD protein.

Group IV, claim(s) 30, drawn to a human cardiomyocyte expressing a recombinant FADD protein.

Group V, claim(s) 42, 45, 46, 47, 48, and 49, drawn to a method of identifying a candidate compound for treating cardiac inflammation in a mammal comprising contacting a

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cardiomyocyte expressing a FADD gene candidate compound and measuring FADD gene expression in said cardiomyocyte.

Group VI, claim(s) 42, 45, 46, 47, 48, and 49, drawn to a method of identifying a candidate compound for treating cardiac inflammation in a mammal comprising contacting a cardiomyocyte expressing a FADD gene candidate compound and measuring FADD protein activity in said cardiomyocyte.

Group VII, claim(s) 51, 54, and 55, drawn to a method for identifying a candidate compound for treating cardiac inflammation or cardiac disorder comprising contacting a FADD protein with a candidate compound and determining whether compound bind said FADD protein.

The inventions listed as Groups I-VII do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons:

37 CFR 1.475(b) states:

“An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

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(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

37 CFR 1.475(c) states:

“If an application contains claims to more or less than one of the combination of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.”

37 CFR 1.475(d) also states:

“If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and 1.476(c).”

37 CFR 1.475(e) further states:

“The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternative within a single claim.”

In view of 37 CFR 1.475 (b), 37 CFR 1.475 (c), 37 CFR 1.475 (d), and 37 CFR 1.475 (e), Group I is considered the main invention to the product first mentioned in the claims, and the first recited invention drawn to other categories related thereto, e.g. a method of making, method of use.

The technical feature linking groups I-VII appears to be a cardiomyocyte expressing a recombinant FADD protein.

However, Chao et al. (JBC, 277:31639-31645, 2002) teaches a cardiomyocyte comprising a wild type or dominant negative form of FADD.

Therefore, the technical feature linking the inventions of groups I-VII does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

The special technical feature of Group I is considered to be a method of treating a cardiac disorder in a mammal comprising administering to said mammal a FADD protein.

The special technical feature of Group II is considered to be a method of treating a cardiac disorder in a mammal comprising administering to said mammal an anti-inflammatory FADD inhibitor.

The special technical feature of Group III is considered to be a human cardiomyocyte expressing a dominant negative FADD protein.

The special technical feature of Group IV is considered to be a human cardiomyocyte expressing a recombinant FADD protein.

The special technical feature of Group V is considered to be a method of identifying a candidate compound for treating cardiac inflammation in a mammal comprising contacting a cardiomyocyte expressing a FADD gene candidate compound and measuring FADD gene expression in said cardiomyocyte.

The special technical feature of Group VI is considered to be to a method of identifying a candidate compound for treating cardiac inflammation in a mammal comprising contacting a

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cardiomyocyte expressing a FADD gene candidate compound and measuring FADD protein activity in said cardiomyocyte.

The special technical feature of Group VII is considered to be a method for identifying a candidate compound for treating cardiac inflammation or cardiac disorder comprising contacting a FADD protein with a candidate compound and determining whether compound bind said FADD protein.

Accordingly, Groups I-VII are not so linked by the same or a corresponding technical feature as to form a single general inventive concept.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Whiteman whose telephone number is (571) 272-0764. The examiner can normally be reached on Monday through Friday from 7:00 to 4:00 (Eastern Standard Time), with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras, SPE – Art Unit 1635, can be reached at (571) 272-4517.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of

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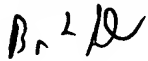
such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center number is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Brian Whiteman



BRIAN WHITEMAN
PATENT EXAMINER